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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,210	08/16/2001	Gordon Wesley Braudaway	YOR919960153US4	3310

7590 06/16/2004

Louis P. Herzberg  
IBM Corporation  
Intellectual Property Law Dept.  
P.O. Box 218  
Yorktown Heights, NY 10598

EXAMINER

DASTOURI, MEHRDAD

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/16/2004

*7*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/931,210

Applicant(s)

BRAUDAWAY ET AL.

Examiner

Mehrdad Dastouri

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, 17, 45-50, 60-67, 74, and 81-83, drawn to method, apparatus and article of manufacture for imparting/detecting watermark onto/in digital images by altering pixel brightness, classified in class 382, subclass 100.
  - II. Claims 19, 54 and 85, drawn to method, apparatus and article of manufacture for generating watermarked images using cryptographic key, classified in class 380, subclass 1.
  - III. Claims 16, 18, 20-38, 43, 44, 51, 53, 55, 56, 58, 59, 68-73, 84, and 86-90, drawn to method, apparatus and article of manufacture for statistical decision process of image watermarking, classified in class 382, subclass 228.
  - IV. Claims 39-42, 52, 57 (Duplicate claim), 75-80 and 82, drawn to method, apparatus and article of manufacture for generating a visual representation of a data array in color space, classified in class 382, subclass 162.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I through IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as inserting and detecting watermarks in digital images. invention II has

separate utility such as protecting documents by inserting a secret code or cipher .  
invention III has separate utility as statistical decision processing. invention IV has  
separate utility as generating a visual representation of a data array in color space.

3. Because these inventions are distinct for the reasons given above and have  
acquired a separate status in the art as shown by their different classification, restriction  
for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must  
include an election of the invention to be examined even though the requirement be  
traversed (37 CFR 1.143).

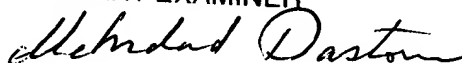
5. Applicant is reminded that upon the cancellation of claims to a non-elected  
invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one  
or more of the currently named inventors is no longer an inventor of at least one claim  
remaining in the application. Any amendment of inventorship must be accompanied by  
a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Mehrdad Dastouri whose telephone number is (703)  
305-2438. The examiner can normally be reached on Monday to Friday from 8:00 a.m.  
to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone number for  
the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**MEHRDAD DASTOURI**  
**PRIMARY EXAMINER**

A handwritten signature in cursive script, reading "Mehrdad Dastouri", written in black ink.

Mehrdad Dastouri  
Primary Examiner  
Art Unit 2623  
June 10, 2004